

REMARKS/ARGUMENTS

Claims 1-49 are pending in the application. In the previous office action all claims were rejected. After consideration of Applicant's response, an advisory action maintaining the rejections was issued. In response, the Applicant has filed a Request for Continued Examination. Applicant respectfully requests that the Examiner consider the arguments presented below regarding the suitability of U.S. Patent 6,433,068 to Morrison et al. (hereafter referred to as "Morrison" or "the Morrison reference"). In this response, no claims are amended or cancelled. No new claims are added. Thus, upon its entry claims 1-49 are pending in the application. No new matter is added.

**RESPONSE TO PROVISIONAL NON-STATUTORY DOUBLE PATENTING
REJECTION**

Claims 1-49 are provisionally rejected based on the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 2, and 6-27 of copending Application Serial No. 09/419,571.

The Applicants respectfully submit that the claims of the present application are patentably distinct from those of copending Application Serial No. 09/419,571. The claims of the present application recite a gelled ester composition that includes a hydrophobic, non-polar solvent in addition to a polymer and the ester. The claims also recite a particular viscosity relationship between the gelled ester, the hydrophobic, non-polar solvent, and the resultant composition. On the other hand, the claims of copending application 09/419,571 do not recite a gelled composition that includes both an ester and a hydrophobic non-polar solvent. And there is no disclosure of the claimed viscosity relationship. Since the copending claims do not recite each and every limitation recited in the claims of the present application and because the copending application does not disclose the claimed viscosity relationship, the current claims are patentably distinct over those of copending application 09/419,571. Therefore, the Applicant respectfully requests that the nonstatutory double patenting rejection be withdrawn.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Morrison. In making the rejection the Examiner stated:

“The rejection as set forth under 35 U.S.C. § 103 in Paper No. 5 is deemed proper and is herein repeated.

Applicants’ arguments have been fully considered but have been deemed to be not persuasive. Applicants extensively argue the law regarding inherency and conclude that the compositions of Morrison do not necessarily have the recited property. This is not persuasive. The compositions as shown in Morrison are seen to render obvious the instantly claimed composition. Applicants have failed to argue any compositional ingredients as instantly claimed which are not rendered *prima facie* obvious by the Morrison disclosure. Given that the Morrison patent renders obvious applicants’ instantly claimed composition, it is reasonable to presume that the Morrison patent also contains properties which either anticipate or render obvious those as instantly claimed. Applicants have failed to show or allege that such is not the case. The fact of the matter is that Morrison does not teach compositions which are specifically outside of the ranges as claimed. More to the point, the Morrison patent is silent as to the claimed property and as such is seen to be generic to the claimed property. This is to say that the Morrison patent generically teaches compositions which render obvious the instantly claimed composition.”

See, Office Action dated December 30, 2003, pages 4-5 (emphasis added).

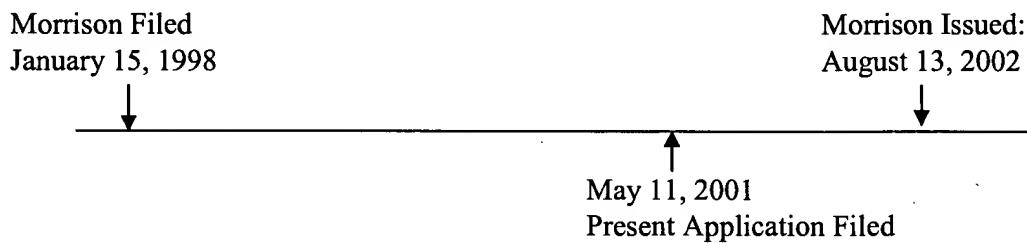
The applicant has considered the rejection in light of the Examiner’s reasoning and respectfully disagrees that Morrison renders the claims unpatentable.

A. Applicable Law

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR § 1.53(b), continued prosecution applications filed under 37 CFR § 1.53(d), and reissues. See MPEP § 706.02(k).

B. Application of the Law**1. THE CLAIMED INVENTION IS NOT RENDERED OBVIOUS BY MORRISON BECAUSE MORRISON CANNOT BE USED AS PRIOR ART AGAINST THE APPLICATION UNDER 35 U.S.C. §103(C)**

The following timeline illustrates the timeline used by Applicant to determine that Morrison cannot be used as prior art against the current application:



As the timeline shows, Morrison was filed before the present application and issued after the present application was filed. Thus, if indeed Morrison discloses the claimed invention, it qualifies as a 102(e). Moreover, the undersigned, an attorney of record, hereby states that the claimed subject matter and the Morrison reference were, at the time when the invention of the present claims was made, were subject to an obligation of assignment to the same person. *See MPEP § 706.02(l)II* (applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person). Morrison is not a proper reference for the purposes of a rejection under 35 U.S.C. §103(a).

Therefore, the Applicants respectfully request that the rejection under 35 U.S.C. §103(a) based Morrison be withdrawn.

CONCLUSION

Applicants have addressed all of the Examiner's rejections. Applicants believe that the claims are now in condition for allowance and respectfully request that the Examiner grant such an action. If any questions or issues remain in the resolution of which the Examiner feels will be advanced by a conference with the Applicants' attorney, the Examiner is invited to contact the attorney at the number noted below. No fees are due as a result of this Reply. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 10-0447, reference 42133-00009USP1 (ABDON).

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Respectfully submitted,

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